



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takashi OHTA et al.

Group Art Unit: 2833

Application No.: 10/602,704

Examiner: A. GILMAN

Filed: June 25, 2003

Docket No.: 113002.01

For: WIRING CONNECTION METHOD AND WIRING CONNECTION STRUCTURE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicants respectfully request review of the Final Rejection mailed June 3, 2005, in the above-identified application.

I. Status of Pending Claims

Claims 10-15 and 18-23 are pending. Claims 10-23 are rejected. No amendments are being filed with this request.

II. Grounds of Rejection Presented For Review

The following grounds of rejection are presented for review: the rejection of claims 10, 11, 13, 14, and 16-23 under 35 U.S.C. §103(a) over U.S. Patent No. 4,703,397 to Minoura et al. in view of U.S. Patent No. 5,724,730 to Tanaka or U.S. Patent No. 4,949,454 to Schauer et al.; and the rejection of claims 12 and 15 under 35 U.S.C. §103(a) over Minoura in view of Tanaka and further in view of U.S. Patent No. 5,287,894 to Shukushima et al. However, claims 16 and 17 are canceled, and thus the rejection of these claims is now moot; claims 10, 11, 13, 14 and 18-23 would not have been rendered obvious by Minoura in view of Tanaka or

Schauer; and claims 12 and 15 would not have been rendered obvious by Minoura in view of Tanaka and Shukushima. Claims 10 and 13 are the only rejected independent claims.

A. Claims 10, 11, 13, 14 and 18-23 would not have been rendered obvious by Minoura in view of Tanaka or Schauer

As discussed in the November 18 Amendment After Final Rejection, there is no motivation to combine Minoura with Tanaka or Schauer. More specifically, Minoura teaches away from such combination.

It is well settled that a rejection based on 35 U.S.C. §103(a) must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

However, it is "improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d, 731, 743, 218 USPQ 769, 779 (Fed. Circ. 1983); see also MPEP §2144 (X)(D). Further, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also MPEP §2143.01. The teachings of the references are not sufficient to render the claims *prima facie* obvious if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As acknowledged by the Office Action, Minoura does not disclose a harness that is welded to the bus bar, wherein the bus bar is integrally molded with the housing, and a point where the harness and the bus bar are welded is integrally molded with the housing integrally molding a point where the harness and the bus bar are welded, with the housing, as recited in claim 10, and as similarly recited in claim 13. The Office Action further asserts that Tanaka or Schauer remedy this deficiency because each reference allegedly discloses a bus bar and harness that are welded with the housing. More specifically, the Office Action asserts that Tanaka and Schauer disclose a bus bar and harness that are undetectably connected to the housing.

However, the object of Minoura is to provide a functional circuit that includes a junction block and an electronic unit pack that is detachably connected to the junction block. See, e.g., Minoura, col. 2, lines 48-54. That is, by detachably connecting the electronic unit pack to the junction block, the pack of Minoura can be exchanged quickly to meet the requirements. See, e.g., Minoura, col. 1, lines 47-56. Further, by providing a functional circuit that incorporates a type wiring device that includes junction block and an electronic unit pack that is detachably connected to the junction block, the device of Minoura may increase permissible current in a through circuit formed in the pack and simultaneously make the pack itself compact. See, e.g., Minoura, col. 2, lines 48-54.

Because the intended purpose of the structure of Minoura is to detachably connect the junction block and electronic unit pack, there is no motivation to combine Minoura with the structure of Tanaka or Schauer to achieve the features recited in claims 10 and 13. In fact, Minoura teaches away from such a combination or modification.

Thus, for at least these reasons, claims 10 and 13 are patentable over Minoura, Tanaka and Schauer. Further, claims 11, 14 and 18-23, which variously depend from claims 10 and

13, are patentable over Minoura, Tanaka and Schauer for at least these reasons, as well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested

B. Claims 12 and 15 would not have been rendered obvious by Minoura in view of Tanaka and Shukushima

Claims 12 and 15 would not have been rendered obvious by Minoura in view of Tanaka and Shukushima. There is no motivation to combine Minoura with Tanaka and Shukushima. As discussed with respect to claims 10 and 13, Minoura teaches away from such combination. Claims 12 and 15 depend from claims 10 and 13, respectively. Thus, claims 12 and 15 are patentable over Minoura, Tanaka, and Shukushima for at least the reasons discussed with respect to claims 10 and 13, as well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested.

III. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the rejections are based upon a clear legal error and that all the pending claims are in condition for allowance. For all of the above reasons, Applicants respectfully request the panel of Examiners

to review the June 3, 2005 Final Rejection prior to Appeal, to withdraw the outstanding rejections. For all of the reasons discussed above, it is respectfully submitted that the rejection is in error and that all the pending claims are in condition for allowance.

Respectfully submitted,



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Attachment:

Notice of Appeal

Date: December 5, 2005

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